

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit	: 1616	Customer No. 035811
Examiner	: Ernst V. Arnold	
Serial No.	: 10/722,737	Docket No.: BSG 021 US
Filed	: November 25, 2003	(END-09-1164R)
Inventors	: Bradley S. Galer	
	: Arnold R. Gammaitoni	Confirmation No.: 7300
	: Robert H. Dworkin	
Title	: COMPOSITIONS AND METHODS	
	: FOR TREATING NEUROPATHIC	
	: SENSORY LOSS	

Dated: July 1, 2010

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Appellants have appealed from the rejection of Claims 1-11. The Appellants submit this Appeal Brief in response to the Official Action dated December 28, 2009. The Appellants submit electronic payment in the amount of \$540 under 41 CFR §41.20(b)(2). The Commissioner is authorized to charge any insufficiency to Deposit Account No. 50-2656.

REAL PARTY IN INTEREST

The real party in interest by Assignment recorded in the USPTO records at Reel 015347 and Frame 0900 is Endo Pharmaceuticals, Inc., a corporation of Delaware, located at 100 Endo Boulevard, Chadds Ford, PA 19317.

RELATED APPEALS AND INTERFERENCES

There are no related appeals, interferences or other cases.

STATUS OF THE CLAIMS

Claims 1-11 are rejected and are on appeal. Claims 1, 9 and 11 are independent claims.

STATUS OF AMENDMENTS

The following Responses are of record: a Response filed November 3, 2009 with an RCE in response to the final Official Action dated September 22, 2009; a Response filed May 28, 2010 in response to the Official Action dated December 28, 2009 and the Interview Summary dated February 17, 2010; and a Notice of Appeal filed July 1, 2010. Claims 1, 9 and 11 were amended in the Appellants' Response filed November 3, 2009. All amendments were entered. A copy of the claims as they now stand is provided in the Claims Appendix.

SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter in independent Claim 1 relates to a method for treating neuropathically-induced negative sensory phenomena in a patient comprising identifying a patient with neuropathically-induced negative sensory phenomena; identifying a locus of the neuropathically-induced negative sensory phenomena; and applying an anesthetic topically to the skin of the patient with neuropathic negative sensory phenomena at or near the locus of the negative sensory phenomena; whereby the neuropathically-induced negative sensory phenomena in the patient is treated. *See* the specification at paragraphs [0007]-[0019] beginning on page 2, at line 8 through page 7, line 19 and Claim 1 on page 9, lines 1-5.

The claimed subject matter in independent Claim 9 relates to a method for treating neuropathically-induced negative sensory phenomena in a patient by topical administration of an anesthetic comprising identifying a patient with neuropathically-induced negative sensory phenomena; identifying a locus of the neuropathically-induced negative sensory phenomena; and applying a non-woven polyester cloth including a physiologically acceptable adhesive, comprising from about 2 to 10% by weight of lidocaine, to the skin of a patient at or near the locus of the negative sensory phenomena; whereby the neuropathically-induced negative sensory phenomena in the patient is treated. *See* the specification at paragraphs [0007]-[0019] beginning on page 2, at line 8 through page 7, line 19 and Claim 9 spanning page 9, line 21 through 10, line 3.

The claimed subject matter in independent Claim 11 relates to a method for decreasing numbness of the skin of a patient comprising identifying a patient with numbness of the skin; identifying a site of the numbness of the skin; and topically applying a local anesthetic to said skin at, or near, the site of said numbness; whereby the numbness of the skin of the patient is decreased. *See*

the specification at paragraphs [0007]-[0019] beginning on page 2, at line 8 through page 7, line 19 and Claim 11 on page 10, lines 6-7.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-11 are rejected as inherently anticipated under 35 USC §102(b) by US Patent No. 5,411,738 (hereinafter US '738) as evidenced by a non-prior art web-page printout designated "MedlinePlus Medical Encyclopedia: Neuralgia" (hereinafter Web-Page) and Rowbotham and Fields, 119 Brain 347 (1996) (hereinafter Rowbotham).

Claims 1-11 are rejected as inherently obvious under 35 USC §103(a) over the combination of US '738 and US Patent Application Publication No. 2004/0101582 (hereinafter US '582) as evidenced by Web-Page and Rowbotham.

ARGUMENT

Rejection of Claims 1-11 as Inherently Anticipated under 35 USC §102(b)

The Appellants respectfully submit that Claims 1-11 are not inherently anticipated under 35 USC §102(b) by US '738 as evidenced by Web-Page and Rowbotham. There are several reasons for this. First, the Examiner has failed to consider all the elements recited in the claims and has ignored the actual recitations of the claims. Second, the cited references fail to establish all the elements of the claimed methods are "necessarily present" in the disclosure of US '738. Third, the cited references fail to teach all the elements of the claimed methods either expressly or inherently.

Failure to Consider All the Elements of the Claims

The Appellants respectfully submit that Claims 1-11 are not inherently anticipated under 35 USC §102(b) by US '738 as evidenced by Web-Page and Rowbotham because the Examiner has ignored the claim elements actually recited in Claims 1-11. This is apparent from the Examiner's statement that:

It remains the Examiner's position that this [(the methods of Claims 1-11)] is simply a method of treating a painful neuralgia in the disguise of treating a symptom of the disorder. Official Action mailed December 28, 2009 at page 9 (emphasis added).

The Examiner reiterates this position on page 10 of the Official Action mailed June 9, 2010. This makes it clear the Examiner is simply ignoring the recitations of the claims because he somehow “just knows” the Appellants are claiming something different than what is actually stated. He is mistaken.

For this reason, the Appellants respectfully submit the inherent anticipation rejections are improper, and should be withdrawn because it is clear the Examiner has failed to consider all the elements of the claimed methods and has impermissibly ignored the actual recitations of the claims.

Failure of the Inherent Anticipation Rejections to Establish the Cited References
“Necessarily” Inherently Disclose All the Elements of the Claimed Methods

The Appellants respectfully submit that Claims 1-11 are not inherently anticipated under 35 USC §102(b) by US ‘738 as evidenced by Web-Page and Rowbotham because the rejections fail to establish all the elements of the claimed methods are “necessarily present” in the disclosure of US ‘738.

Basing a rejection on the doctrine of inherent anticipation is an acknowledgement that a primary reference does not expressly disclose all the elements of an applicant’s claims. Here, US ‘738 never expressly discloses a method for treating the indications of “neuropathically-induced sensory phenomena” or “numbness” in patients with the anesthetic compositions recited in the amended claims. Consequently, the rejection depends on Web-Page and Rowbotham to show that the methods disclosed in US ‘738 “for the relief of pain” in patients with “post-herpetic neuralgia” would somehow inherently involve treating “neuropathically-induced negative sensory phenomena” or “numbness” to restore sensation with the anesthetic compositions recited in the claims.

Inherent anticipation requires that an element which is not expressly recited in a reference must be “necessarily present” and that this “would be so recognized by persons of ordinary skill.” *See e.g.*, MPEP 2131.01 at part III; *see also Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). Stated differently, inherency may not be established by mere probabilities or possibilities. *See e.g.*, *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999). Additionally, the Patent Office has the burden of providing “a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *See Ex Parte Levy*, 17 USPTO 2d 1461 (Bd. Pat. App. & Inter. 1990)

(emphasis added). The Appellants respectfully submit the rejections fail to satisfy this burden or otherwise establish inherent anticipation.

This is because “negative sensory phenomena” or “numbness” are separate disease symptoms from pain and may be entirely absent in patients suffering from “post-herpetic neuralgia.” Thus, “negative sensory phenomena” or “numbness” are not “necessarily present” in patients suffering from “post-herpetic neuralgia” despite the contrary assumption of the rejection.

The distinction between numbness and pain symptoms, and the fact that numbness is not necessarily present in post-herpetic neuralgia patients, is apparent on considering the art accepted definitions of “neuralgia” and “post-herpetic neuralgia” as well as other teachings in the peer-reviewed medical literature relating to “post-herpetic neuralgia.”

“Neuralgia” is defined as “acute paroxysmal pain radiating along the course of one or more nerves ... [usually] without demonstrable changes in the nerve structure” or as “[p]lain of a severe, throbbing, or stabbing character in the course or distribution of a nerve...[etymology=] [neur- + G. *algos*, pain].” See *Merriam Webster’s Medical Desk Dictionary*, 471 (1993) (emphasis added); see also *Stedman’s Medical Dictionary, 28th Edition*, 1307 (28th Ed. 2006) (emphasis added). Stated differently, “neuralgia” is a type of pain—not a type of “negative sensory phenomena” or “numbness.”

Moreover, “post-herpetic neuralgia” or “PHN” is defined as “causalgia [(burning pain)] and hyperesthesia [(excessive, painful sensitivity to sensory stimuli)] in the dermatome served by a spinal nerve infected by herpes zoster, persisting after resolution of the skin eruption; typically occurs in middle-aged and old people [(and)]; may continue for weeks, months or years.” See *Stedman’s Medical Dictionary, 28th Edition*, 1307 (28th Ed. 2006). Stated differently “post-herpetic neuralgia” is a type of pain following herpes zoster infection—not a type of “negative sensory phenomena” or “numbness.”

What is more, it is apparent from a brief review of the medical literature that “negative sensory phenomena” or “numbness” are not “necessarily present” in patients presenting with “post-herpetic neuralgia.” This can be seen from the disclosure in Hasnie as well as the Rowbotham reference relied on in the rejections. See Hasnie *et al.*, 144 *Neuroscience* 1495 (February 23, 2007) (previously made of record in the Response and IDS filed November 3, 2009); see also Rowbotham and Fields, 119 *Brain* 347 (1996) (previously made of record in the Response and IDS filed November 3, 2009). For example, Hasnie states:

In established postherpetic neuralgia the clinical phenotype varies between individual patients and possibly over the time course of the disease. A spectrum of abnormal sensory phenomena have been documented, with hyper-sensory phenomena, such as [(pain elicited by ordinarily non-painful stimuli)] and hyperalgesia [(allodynia increased sensitivity to pain or enhanced sensitivity to pain)], at one extreme and a predominantly hyposensory picture [(a deficient response to stimuli)] with pain in the context of partial or complete sensory loss at the other. Hasnie at page 8 (emphasis added).

Thus, Hasnie teaches that post-herpetic neuralgia can occur without “negative sensory phenomena” or “numbness” and that patients with post-herpetic neuralgia can have only painful symptoms.

This is also apparent from Rowbotham. For example, Rowbotham states:

In a previous study of PHN [(post-herpetic neuralgia)] patients (1989), we were struck by how many patients with severe pain had little, if any, sensory deficit in the region they felt was the source of their most severe pain. Rowbotham at page 348 (emphasis added).

Rowbotham also states that:

[T]here is no simple relationship between loss of peripheral nerve function and spontaneous or evoked pain [in PHN patients]. Rowbotham at page 347.

Moreover, Rowbotham presents clinical data in Figs. 3 and 5 showing that patients can have “post-herpetic neuralgia” without any sensory deficits, such as thermal sensory deficits. See Rowbotham at page 350, Figs. 3 and 5. Thus, Rowbotham also teaches, and demonstrates in the clinic, that post-herpetic neuralgia can occur without “negative sensory phenomena” or “numbness” and patients with post-herpetic neuralgia can have only painful symptoms. The rejection ignores these teachings in Rowbotham.

The Web-Page reference relied on in the rejection to show inherency is also deficient. In particular, Web-Page incorrectly states that a symptom of “neuralgia” is “numbness of the affected skin area (feeling similar to a local anesthetic, such as a Novocain shot).” This error is proven from the above definitions of “neuralgia” provided by art accepted authorities. Clearly, the painful symptoms of neuralgia such as “acute paroxysmal pain,” “pain of a severe, throbbing or stabbing

character” and burning pain such as in “causalgia” are nothing like “numbness” and are, in fact, quite the opposite of the sensations that occur once a shot of the local anesthetic NOVOCAIN™ takes effect. Moreover, the Appellants respectfully submit that the presence of such errors in Web-Page is one reason why this reference contains an explicit disclaimer which states:

The information provided should not be used during any medical emergency or for the diagnosis or treatment of any medical condition. A licensed physician should be consulted for diagnosis and treatment of any and all medical conditions. Call 911 for all medical emergencies. Adam makes no representation or warranty regarding the accuracy, reliability, completeness, currentness, or timeliness of the content, text or graphics. Web-Page at page 3 (emphasis added).

In contrast, Hasnie and Rowbotham are articles written by medical and scientific professionals and published in respected, peer-reviewed medical journals, whose conclusions are based on actual clinical results presented in the articles. Thus, the Appellants respectfully submit that the advice in the Web-Page disclaimer should be followed and this document should not be relied on—particularly to support the current inherent anticipation based rejections—because it contains erroneous information.

It is also apparent from the literature that the pain of “post-herpetic neuralgia” can occur without “negative sensory phenomena” or “numbness” and patients with post-herpetic neuralgia can have only painful symptoms. This means that US ‘738 does not inherently disclose treatment of “negative sensory phenomena” or “numbness” because patients with “post-herpetic neuralgia” do not necessarily have symptoms of “negative sensory phenomena” or “numbness.” In fact, US ‘738 acknowledges this when it states that “PHN patients nearly always have a sensory deficit in the region obtained.” See US ‘738 at column 1, lines 28-30 (emphasis added). Importantly, “nearly” always having a symptom is nothing like a symptom “necessarily being present.” Thus, it is inappropriate to infer, based on the erroneous disclosure of the Web-Page reference, and contrary to the teachings in the accepted, peer-reviewed medical literature, that these patients necessarily present any symptom in addition to pain from “post-herpetic neuralgia,” such as numbness. US ‘738 does not disclose that patients treated with the disclosed methods exhibit any symptom other than “pain” from “post-herpetic neuralgia.”

In fact, all that is disclosed about the patients in US ‘738 treated with the disclosed methods for the “relief of pain” is that these patients had pain, specifically post-herpetic neuralgia,—not

“neuropathically-induced negative sensory phenomena” or “numbness.” This is evident from several different statements in US ‘738. For instance, the description of the “FIRST STUDY” in US ‘738 states that:

Claims for the effectiveness of the invention are supported by the results of a study undertaken by Rowbotham, M. C. and Fields, H. L., Department of Neurology, School of Medicine, University of California, San Francisco. This study entitled “Topical Lidocaine Reduces Pain in Post Herpetic Neuralgia”, Pain (1989) 38:297-301, presents data from experience with 11 patients who had well-established post-herpetic neuralgia (pain present for more than 3 months after healing of the rash of herpes zoster); well-demarcated areas of skin with marked allodynia (pain resulting from a nonnoxious stimulus to normal skin) from light stroking with a cotton wisp; and no medical contraindications to the use of local anesthetics.

Six women and five men participated in the study. The average age [*sic*] was 70 years. Six patients had post-herpetic neuralgia that included the ophthalmic division of the trigeminal nerve, and five had postherpetic neuralgia located in thoracic dermatomes.

The duration of pain ranged from 3 months to 12 years.

All subjects except two were in good general health. One patient had multiple cardiovascular problems, and another had widespread multiple myeloma.

In all cases, post-herpetic neuralgia was the only significant pain problem during the period of the study. US ‘738 at column 5, lines 45-68 to column 6, lines 1-5 (emphasis added).

The description of the “SECOND STUDY” in US ‘738 states:

Subjects were eligible if they had pain present more than 1 month after healing of the zoster skin rash, had a well defined area of painfully sensitive skin, were in stable health, had no medical contraindications to topical local anesthetic application, and had not previously undergone neurolytic or neurosurgical therapy for PHN. US ‘738 at column 7, lines 12-18 (emphasis added).

While the description of the “THIRD STUDY” in US ‘738 states:

Subjects were eligible if they had PHN, defined as pain present more than 1 month after healing of the skin rash, had a well defined area of painfully sensitive skin on the torso or limbs, were in stable health, had no medical contraindications to topical local anesthetic application, and had not undergone neurolytic or neurosurgical therapy for PHN. US ‘738 at column 14, lines 29-35 (emphasis added).

Altogether, this makes it very clear (almost painfully clear) that the patients described in US '738 had pain from PHN, that having pain from PHN was the only symptom the patients in US '738 were known to have and that this pain was the symptom treated with the disclosed "method[s] for the relief of pain." It is also clear from Hasnie and Rowbotham that, the patient does not "necessarily" have "neuropathically-induced negative sensory phenomena" or "numbness."

Stated differently, US '738 is silent regarding the treatment of "negative sensory phenomena" or "numbness" with the anesthetic compositions of Claims 1-11 and contriving to cure this deficiency by reliance on Web-Page and Rowbotham is improper. Moreover, even assuming that the references factually establish "negative sensory phenomena" or "numbness" might be present, would still not be sufficient. "Might be" surely is not "necessarily" present and, accordingly, negative sensory phenomena are anything but inherent in patients suffering from PHN. This means the Appellants have rebutted the conclusions of the rejection and shown that US '738 does not inherently disclose all the elements of the claimed methods.

In fact, the Appellants note that, in the telephonic interview of January 7, 2010, the Examiner conceded the Appellants' position that patients can have post-herpetic neuralgia (pain) without having any symptoms of negative sensory phenomena or numbness was correct. See Examiner's Interview Summary dated February 17, 2010. During the interview, the Examiner explained this was because the symptoms of patients with post-herpetic neuralgia represent a spectrum and not every post-herpetic neuralgia patient will have symptoms of negative sensory phenomena or numbness. See e.g., Examiner's Interview Summary dated February 17, 2010 at lines 13-16, which states:

Therefore, while it is understood that not all patients will experience the same symptoms it is clear that a deficit in the perception of gentle touches, which Applicant defines as the negative sensory phenomena numbness, is a symptom of postherpetic [*sic*] neuralgia and is experienced by some fraction of this patient population.

The Examiner nevertheless then continued to insist, based on Rowbotham, that even though only some post-herpetic neuralgia patients might have symptoms of negative sensory phenomena or numbness, he was maintaining the rejections on this basis. Thus, the Appellants also respectfully submit, based on the Examiner's comments during the interview, that the inherent anticipation rejections are improper because the Appellants have established, in rebuttal, that the elements of the claimed methods are not "necessarily present" in the disclosure of US '738.

For these reasons, the Appellants respectfully submit the inherent anticipation rejections are improper and should be withdrawn.

*Failure of the Inherent Anticipation Rejections to Establish the
Cited References Teach All the Elements of the Claimed Methods*

The Appellants respectfully submit that Claims 1-11 are not anticipated under 35 USC §102(b) by US '738 as evidenced by Web-Page and Rowbotham because the cited references fail to teach all the elements of the amended claims. Independent Claim 1 recites the steps of "a) identifying a patient with neuropathically-induced negative sensory phenomena; b) identifying a locus of the neuropathically-induced negative sensory phenomena; and c) applying an anesthetic topically to the skin of the patient with neuropathic negative sensory phenomena at or near the locus of the negative sensory phenomena; whereby the neuropathically-induced negative sensory phenomena in the patient is treated." Independent Claim 9 recites the steps of "a) identifying a patient with neuropathically-induced negative sensory phenomena; b) identifying a locus of the neuropathically-induced negative sensory phenomena; and c) applying a non-woven polyester cloth including a physiologically acceptable adhesive, comprising from about 2 to 10% by weight of lidocaine, to the skin of a patient at or near the locus of the negative sensory phenomena; whereby the neuropathically-induced negative sensory phenomena in the patient is treated." Independent Claim 11 recites the steps of "a) identifying a patient with numbness of the skin; b) identifying a site of the numbness of the skin; and c) topically applying a local anesthetic to said skin at, or near, the site of said numbness; whereby the numbness of the skin of the patient is decreased." US '738 fails to teach these steps of the claimed methods and Web-Page and Rowbotham both fail to show these steps are necessarily present in the disclosure of US '738. In particular, US '738 does not disclose the steps of identifying a patient with neuropathically-induced negative sensory phenomena, identifying the locus of this phenomena and applying anesthetic to that locus. This means there can be no anticipation, including inherent anticipation, under 35 USC §102(b) of Claims 1-11 by US '738 as evidenced by Web-Page and Rowbotham because the cited references simply do not teach all the steps of the claimed methods either expressly or inherently.

This is unsurprising considering that, as discussed above, US '738 only concerns the treatment of patients with pain, specifically post-herpetic neuralgia—not patients with

“neuropathically-induced negative sensory phenomena” or “numbness.”

Thus, the above discussion makes it clear Claims 1-11 are not inherently anticipated by US ‘738 in view of Web-Page and Rowbotham.

For these reasons, the Appellants respectfully submit the inherent anticipation rejections are improper and should be withdrawn.

Rejection of Claims 1-11 as Inherently Obvious under 35 USC §103(a)

Claims 1-11 are, paradoxically, rejected as inherently obvious under 35 USC §103(a) over US ‘738 and US ‘582 in view of Web-Page and Rowbotham. Claims 1-11 are not obvious over US ‘738 and US ‘582 in view of Web-Page and Rowbotham. There are several reasons for this. First, the Examiner has failed to consider all the elements recited in the claims and has ignored the actual recitations of the claims. Second, the Examiner has improperly taken notice of a so-called “universal fact” to assert that MPEP 2124 permits the use of Web-Page in the obviousness rejections. Third, the obviousness rejections improperly rely on the doctrine of inherent anticipation and references that are not prior art. Fourth, the cited references fail to teach all the elements of the claimed methods. Fifth, the Appellants have discovered that unexpected results are achieved by treating patients with the anesthetics used in the claimed methods of treatment and this is compelling evidence of non-obviousness. Sixth, one of ordinary skill in the art would not be motivated to perform the claimed methods based on the teachings of the cited references or to reasonably expect success on so doing.

Failure of the Obviousness Rejections to Consider All the Elements of the Claims

The Appellants respectfully submit that Claims 1-11 are not obvious under 35 USC §103(a) over US ‘738 and US ‘582 in view of Web-Page and Rowbotham because the Examiner has ignored the claim elements actually recited in Claims 1-11. As discussed above regarding the inherent anticipation rejections, this is apparent from the Examiner’s statement, reproduced below, that:

It remains the Examiner’s position that this [(the methods of Claims 1-11)] is simply a method of treating a painful neuralgia in the disguise of treating a symptom of the disorder. Official Action

mailed December 28, 2009 at page 9 and the Official Action mailed June 9, 2010 at page 10 (emphasis added).

Once again, this makes it clear the Examiner simply ignores the recitations of the claims because he somehow “just knows” the Appellants are claiming something different; *i.e.*, treatment of pain, when in fact the appealed claims recited “negative sensory phenomena,” which is defined in Appellants’ specification at paragraphs [0011] and [0002] as “numbness and decreased sensation...manifested as the decreased ability to feel light touch, pain, proprioception, vibration, warmth/heat, and coolness/cold.” As stated above, he is mistaken.

Thus, the Appellants also respectfully submit for this reason, that the inherent obviousness rejections are improper because it is clear the Examiner has failed to consider all the elements of the claimed methods and has impermissibly ignored the actual recitations of the claims.

Improper Notice of a “Universal Fact”

The Appellants respectfully submit that Claims 1-11 are not obvious under 35 USC §103(a) over US ‘738 and US ‘582 in view of Web-Page and Rowbotham because the Examiner improperly takes notice of a so-called “universal fact” to assert that MPEP 2124 permits the use of Web-Page in the obviousness rejections. The “universal fact” referred to appears to be the Examiner’s assertion that “negative sensory phenomena” or “numbness” are “necessarily present” in patients presenting “post-herpetic neuralgia.”

There is no such “universal fact.” Instead, what is true is that “negative sensory phenomena” or “numbness” are separate symptoms that may be entirely absent in patients suffering from post-herpetic neuralgia. This was demonstrated by the evidence the Appellants cited in rebuttal of the Examiner’s assertions concerning Web-Page. Specifically, as discussed above regarding the inherent anticipation rejections, the Examiner’s assertion of a “universal fact” is contrary to art-accepted dictionary definitions as well as the disclosure and data in the peer reviewed Hasnie and Rowbotham journal articles. *See* sub-heading entitled “Failure to Establish the Cited References “Necessarily” Inherently Disclose All the Elements of the Claimed Methods” *supra*.

What is more, and as discussed above, in the telephonic interview of January 7, 2010, the Examiner conceded the Appellants’ position--that patients can have post-herpetic neuralgia (pain) without having any symptoms of negative sensory phenomena or numbness--was correct. *See*

Examiner's Interview Summary dated February 17, 2010. During the interview, the Examiner explained this was because the symptoms of patients with post-herpetic neuralgia represent a spectrum and not every post-herpetic neuralgia patient will have symptoms of negative sensory phenomena or numbness, but nevertheless some post-herpetic neuralgia patients might have symptoms of negative sensory phenomena or numbness. See e.g., Examiner's Interview Summary dated February 17, 2010 at lines 13-16.

The Examiner cannot have it both ways. Either a "universal fact" is universally, and unequivocally, true in all instances or it is not. Here, it is not and the Web-Page is therefore not available for application in obviousness rejections to show a so-called "universal fact" as described in MPEP 2124. Moreover, the teachings in Rowbotham which are contrary to the Examiner's assertions here have, again, conveniently been ignored.

Thus, for these reasons, the Appellants respectfully submit the obviousness rejections are improper because they rely on the Web-Page reference which is not prior art and does not represent a universal fact.

Improper Reliance on the Doctrine of Inherent Anticipation

The Appellants respectfully submit that Claims 1-11 are not obvious under 35 USC §103(a) over US '738 and US '582 in view of Web-Page and Rowbotham because the obviousness rejections improperly rely on the doctrine of inherent anticipation. This is apparent from the comments on page 7 of the Official Action regarding "incorporation" of the inherent anticipation arguments relating to US '738, Web-Page and Rowbotham into the obviousness rejections. This can also be seen from the fact that the obviousness rejection depends on US '738, Web-Page and Rowbotham as the core combination of references supporting the obviousness rejections. This is despite the fact that Web-Page is not prior art under 35 USC §102, because the priority date for this application is November 25, 2003 and the publication date for Web-Page is not apparent from this document, but in any event is asserted by the Examiner to be September 6, 2006. See "Notice of References Cited" entered January 13, 2009. Thus, the rejections fail on this basis to establish *prima facie* obviousness.

The doctrine of inherent anticipation cannot properly be applied in the context of 35 USC §103 obviousness rejections. See e.g., *In re Spormann and Heinke*, 150 USPQ 499 (CCPA 1996); see also *In re Rijckaert and Kop*, 9 F.3d 1531 (Fed. Cir. 1993). Yet, the rejections incorrectly rely on

arguments which conflate anticipation, and anticipation-related doctrines, with obviousness and obviousness-related doctrines. Such conflation is prohibited because it is apparent from the case law, such as *Atlas Powder Co. v. Ireco Inc.* (190 F.3d 1342 (Fed. Cir. 1999)) and other cases, that the application of the inherent anticipation doctrine is limited to the context of 35 USC §102 anticipation not obviousness under 35 USC §103. Moreover, it is self evident to state:

That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown. *In re Spormann and Heinke supra* at 452 (emphasis added).

Stated differently, this means application of the inherency doctrine is limited to anticipation based rejections made under 35 USC §102.

This makes sense. The anticipation doctrine is concerned with the issue of novelty and whether a claimed invention, such as a composition or method, was disclosed in the prior art before the occurrence of the events identified in 35 USC §102. *See e.g.* 35 USC §102 and *Atlas Powder Co. supra* at 1347-1348. The doctrine of inherent anticipation ensures members of the public remain free to make, use or sell prior art compositions, or methods, regardless of whether they recognize the complete makeup and properties of a prior art composition or the underlying scientific principles that allow a prior art process to operate. *See Atlas Powder Co. supra* at 1348. If it turns out a composition or method was previously disclosed it is not novel and cannot be patented.

In contrast, obviousness doctrine is concerned with the issue of whether a member of the public would, based on his knowledge and the prior art at the time an invention was made, have combined the teachings of the prior art to make the claimed invention. The language of 35 USC §103(a) states that:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. 35 USC §103(a) (emphasis added).

This language makes several things plain. First, obviousness is determined “at the time the invention was made” and this determination is based on what a person of ordinary skill in the art

would have known from “the prior art.” See 35 USC §103(a). In fact, it is well settled that “[a] *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” See *In re Rijckaert and Kop supra* at 1532 (citing *In re Bell*, 991 F.2d 781 (Fed. Cir. 1993)); and *In re Rinehart*, 531 F.2d 1048 (CCPA 1976). However, as one court stated, and which appears to apply with particular force here:

[T]he examiner’s assumptions do not constitute the disclosure of the prior art. We agree. *In re Rijckaert and Kop supra* at 1533.

Together, this means references that are not “prior art” cannot be considered in the obviousness analysis. This also means that a non-prior art document, such as Web-Page, published sometime after an application was filed cannot be considered in the obviousness analysis for the simple reason that it did not exist “at the time the invention was made.” In addition, this means that only “the teachings of the prior art itself,” *i.e.*, what one of ordinary skill in the art would have known from just the prior art can be considered in the obviousness analysis. See *e.g.*, *In re Rijckaert and Kop supra* at 1532. Most importantly, relying on inherent, hidden disclosure in a reference which would have been unknown and unrecognized by a person of ordinary skill in the art at the time an invention was made is improper in obviousness rejections. Stated differently, this means there can be no such thing as “inherent obviousness” and to assert otherwise, as the Examiner has, is simply paradoxical and improper

Here, this means the obviousness rejections are improper because they rely on the non-prior art Web-Page reference, they rely on inherent disclosure instead of what one of ordinary skill in the art would have recognized and known from the prior art and they rely on “inherent anticipation” arguments based on the Examiner’s incorrect assumptions concerning disclosure he believes is disguised in the prior art. This also means the Examiner’s reliance on MPEP 2131.01 III, which deals with the use of non-prior art references in “inherent anticipation” rejections, to justify the citation of Web-Page in the obviousness rejections is improper.

For these reasons, the Appellants respectfully submit the obviousness rejections are improper and should be withdrawn.

Failure of the Obviousness Rejections to Establish the Cited References

Teach All the Elements of the Claimed Methods

The Appellants respectfully submit that Claims 1-11 are not obvious under 35 USC §103(a) because US '738 and US '582 in view of Web-Page and Rowbotham fail to teach all the elements of the amended claims. This is because, as discussed above, the core combination of US '738 in view of Web-Page and Rowbotham fails to teach all the elements of Claims 1-11 either expressly or inherently. See sub-headings entitled "Failure of the Inherent Anticipation Rejections to Establish the Cited References 'Necessarily' Inherently Disclose All the Elements of the Claimed Methods" and "Failure of the Inherent Anticipation Rejections to Establish the Cited References Disclose All the Elements of the Claimed Methods" *supra*. The citation of US '582 does nothing to cure this deficiency of the core combination of references. Moreover, the combination of US '738, US '582 and Rowbotham also fails to teach all the elements of Claims 1-11. This is important because, as discussed above, Web-Page is not available as prior art for application in the present obviousness rejections.

For these reasons, the Appellants respectfully submit the obviousness rejections are improper and should be withdrawn.

Unexpected Results

Claims 1-11 are not obvious under 35 USC §103(a) over US '738 and US '582 in view of Web-Page and Rowbotham because the Appellants discovered unexpected results are achieved by treating patients with the anesthetics used in the claimed methods of treatment. Anesthetic compositions are intended to deprive patients of sensory perception. Importantly, the Appellants have defied the teachings in the art and unexpectedly found that a topically applied anesthetic could treat the conditions of neuropathically-induced "negative sensory phenomena" or "numbness" of the skin in patients. See originally filed application at paragraphs [0018]-[0019], on page 7, lines 1-19. In fact, patients with these symptoms experienced an "improvement of sensory loss (decreased numbness), and improved tactile response (they could better feel objects touching their skin)." See originally filed application at paragraphs [0018]-[0019], on page 7, lines 1-19. The Appellants respectfully submit this new use for a topically applied anesthetic is compelling evidence of non-

obviousness. Additionally, the Appellants respectfully submit that, in view of these unexpected results, the rejections are based on improper hindsight reasoning.

The Appellants also note it is well settled that a new and unexpected use for a previously known composition, such as in a method of treatment claim like those of Claims 1-11, can be novel, non-obvious and patentable. *See e.g., In re Spada and Wilczynski*, 911 F.2d 705, 708 (Fed. Cir. 1990) *citing In re Hack*, 245 F.2d 246 (1957).

For these reasons, the Appellants respectfully submit the obviousness rejections are improper and should be withdrawn.

*Failure of the Cited References to Establish Motivation or a
Reasonable Expectation of Success for One of Ordinary Skill in the Art*

The Appellants respectfully submit that Claims 1-11 are not obvious under 35 USC §103(a) over US '738 and US '582 in view of Web-Page and Rowbotham because one of ordinary skill in the art would not be motivated by the cited references to perform the claimed methods, or reasonably expect success on so doing. This is because nothing in the cited references appears to suggest that a topically applied anesthetic (*i.e.*, a compound known to block sensation) can cause sensation to return or improve tactile response and sensory loss in patients with neuropathically-induced “negative sensory phenomena” or “numbness” of the skin. In fact, the cited references, such as US '738 and US '582, appear to teach away from this because they clearly focus on the use of anesthetics to reduce, or eliminate, sensations such as pain. *See e.g.*, US '738 at column 3, lines 20-54 and US '582 at paragraph [0039]. Even the non-prior art Web-Page reference teaches away from this use of anesthetics when it notes that a local anesthetic, such as a NOVOCaine™, produces a feeling of numbness in an affected skin area. Importantly, as discussed above, the Appellants have defied the teachings in the art and unexpectedly found that a topically applied anesthetic could treat the conditions of neuropathically-induced “negative sensory phenomena” or “numbness” of the skin in patients. The Appellants again respectfully submit this is compelling evidence of non-obviousness and that one of ordinary skill in the art would not be motivated by the cited references to perform the claimed methods, or reasonably expect success on so doing.

*The Claimed Methods are More Than the Predictable Use of Prior Art Elements According to
their Established Functions*

The Appellants respectfully submit that Claims 1-11 are not obvious under 35 USC §103(a) over US '738 and US '582 in view of Web-Page and Rowbotham because the claimed methods are more than the predictable use of prior art elements according to their established functions. As discussed above, the Appellants defied the conventional wisdom of the art and discovered unexpected results are achieved by treating patients with the anesthetics used in the claimed methods of treatment. The Appellants surprisingly found that a topically applied anesthetic (*i.e.*, a compound known to block sensation) can cause sensation to return or improve tactile response and sensory loss in patients with neuropathically-induced "negative sensory phenomena" or "numbness" of the skin.

This required the Appellants to ignore the "common sense" understanding of a person of ordinary skill in the art that the "established function" of anesthetic compositions is to deprive patients of sensory perception. This "common sense" understanding, the "established function" and the predicted results one of ordinary skill in the art would have expected from the administration of anesthetics, are apparent throughout the cited references, such as US '738 and US '582, which clearly teach the use and function of anesthetics is to reduce, or eliminate, sensations such as pain. *See e.g.*, US '738 at column 3, lines 20-54 and US '582 at paragraph [0039]. In fact, even the non-prior art Web-Page reference demonstrates this "common sense" understanding of the established function and predicted results from the use of anesthetics when it notes that a local anesthetic, such as a NOVOCINE™, produces a feeling of numbness in an affected skin area.

The Appellants contravened "common sense" and ignored predictions based on the art-established functions of anesthetics to arrive at the claimed methods. This required the Appellants to ignore the normal inferences those skilled in the art would have made concerning the administration of anesthetics and to utilize creative steps that a person of ordinary skill in the art simply would not have employed. Thus, in performing the claimed methods the Appellants had to do something that was not obvious to try. Additionally, this meant the Appellants had to use more than mere "ordinary creativity" to arrive at the claimed methods and that the unexpected results obtained with these methods were not reasonably predictable.

For these reasons, the Appellants respectfully submit the obviousness rejections are improper and should be withdrawn.

In light of the foregoing, the Appellants respectfully request that the rejections of Claims 1-11 accordingly be reversed.

Respectfully submitted,



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Claims Appendix

1. (Previously Presented) A method for treating neuropathically-induced negative sensory phenomena in a patient comprising:

- a) identifying a patient with neuropathically-induced negative sensory phenomena;
- b) identifying a locus of the neuropathically-induced negative sensory phenomena; and
- c) applying an anesthetic topically to the skin of the patient with neuropathic negative sensory phenomena at or near the locus of the negative sensory phenomena; whereby the neuropathically-induced negative sensory phenomena in the patient is treated.

2. (Previously Presented) The method of claim 1, wherein said anesthetic is a benzoic acid derivative.

3. (Original) The method of claim 2, wherein said benzoic acid derivative is selected from the group consisting of benzocaine, procaine, tetracaine, chlorprocaine, propoxycaine, cocaine, proparacaine, mepivacaine, bupivacaine, phenocaine, dibucaine, etidocaine, lidocaine, prilocaine, and pharmaceutically acceptable salts thereof.

4. (Original) The method of claim 3, wherein the benzoic acid derivative is lidocaine.

5. (Original) The method of claim 4, wherein the lidocaine is contained in a patch.

6. (Original) The method of claim 5, wherein said patch contains between about 2% and about 10% lidocaine.

7. (Original) The method of claim 6, wherein said patch contains about 5% lidocaine.

8. (Original) A method according to claim 1, wherein method further comprises applying a cover over said anesthetic, said cover formed from a material selected from the group consisting of polyvinyl chloride, polyvinylidene chloride, polyethylene, synthetic rubber, woven polyester fabric, and non-woven polyester fabric.

9. (Previously Presented) A method for treating neuropathically-induced negative sensory phenomena in a patient by topical administration of an anesthetic, said method comprising:

- a) identifying a patient with neuropathically-induced negative sensory phenomena;
- b) identifying a locus of the neuropathically-induced negative sensory phenomena; and
- c) applying a non-woven polyester cloth including a physiologically acceptable adhesive, comprising from about 2 to 10% by weight of lidocaine, to the skin of a patient at or near the locus of

the negative sensory phenomena; whereby the neuropathically-induced negative sensory phenomena in the patient is treated.

10. (Original) A method according to claim 9, wherein said lidocaine is present in about 5% by weight.

11. (Previously Presented) A method for decreasing numbness of the skin of a patient comprising:

- a) identifying a patient with numbness of the skin;
 - b) identifying a site of the numbness of the skin; and
 - c) topically applying a local anesthetic to said skin at, or near, the site of said numbness;
- whereby the numbness of the skin of the patient is decreased.

Evidence Appendix

None.

Related Proceedings Appendix

There are no related proceedings.